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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,674	07/13/2001	Christoph Reinhard	PP-01700.002 / 200130.521	4819

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EXAMINER

LACOURCIERE, KAREN A

ART UNIT

PAPER NUMBER

1635

DATE MAILED: 09/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/905,674	REINHARD ET AL.	
	Examiner	Art Unit	
	Karen Lacourciere	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 8-11, drawn to a nucleic acid TSPAN-7 inhibitor classified in class 536, subclass 24.5.
- II. Claims 1, 6, 7, 8-11 and 20-22, drawn to antibody to TSPAN-7, classified in class 530, subclass 387.1.
- III. Claims 12-16, drawn to method of making a recombinant vector and recombinant host cell, classified in class 435, subclass 455.
- IV. Claims 17-19, drawn to an epitope, classified in class 530, subclass 300.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different products that are not used together and have different modes of operation. For example, the nucleic acid inhibitors of Group I are composed of nucleotides and operate by inhibiting the expression of TSPAN-7, which is different than the antibody inhibitors of Group II, which are composed of amino acids and act by binding to the TSPAN-7 protein, inhibiting its activity.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different functions. For example, the nucleic acid TSPAN-7 inhibitors of Group I function to inhibit the expression of TSPAN-7, whereas the recombinant vectors and host cells of Group III function to encode and express a TSPAN-7 protein.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different products that are not used together and have different functions. For example, the nucleic acid inhibitors of Group I are composed of nucleotides and function to inhibit the expression of TSPAN-7, which is different than the epitopes of Group IV, which are composed of amino acids and act to provide an antigen which can be recognized by an antibody.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different products that are not capable of use together and have different functions. For example, the antibodies of Group II are composed of amino acids and function to inhibit the activity of

TSPAN-7 protein, whereas the vectors and recombinant cells of Group III and composed of nucleic acids and function to encode and express a TSPAN-7 protein.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to products that are not used together and have different functions. For example, the antibodies of Group II function to inhibit the activity of TSPAN-7 protein, whereas the epitopes of Group IV are fragments of the TSPAN-7 protein and function to provide an antigen of the TSPAN-7 protein.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to materially different products that have different functions. For example, the recombinant vectors and host cells of Group III are composed of nucleic acids and function to encode and express a polypeptide, whereas the epitopes of Group IV are composed of amino acids and function to provide an antigen for an antibody.

Restriction to one sequence:

If Applicant should choose to elect Group I, an additional restriction requirement is applied to this group, in that Applicant is required to elect one antisense sequence for examination. Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the antisense sequences

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listed in claim 4 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, up to 10 of independent and distinct nucleotide sequences will be examined in a single application. (see MPEP 803.04 and 2434)

Claim 4 specifically claims antisense SEQ ID NOS 3-7, which are targeted to and modulates the expression of TSPAN-7. Although the antisense sequences claimed each target and modulate expression of the same gene, the instant antisense sequences are considered to be unrelated, since each antisense sequence claimed is structurally and functionally independent and distinct for the following reasons: each antisense sequence has a unique nucleotide sequence, each antisense sequence targets a different and specific region of the gene encoding TSPAN-7, and each antisense, upon binding to the gene encoding TSPAN-7, functionally modulates (increases or decreases) the expression of the gene and to varying degree (per applicants' Tables 1 and 2 in the specification). Furthermore, a search of more than one (1) of the antisense sequences claimed in claim 4 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed antisense sequences. In view of the foregoing, one (1) antisense sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1) antisense sequence from claim 4. Examination of Group I will be limited to examination of this single antisense sequence.

Claims 1 and 8-11 are generic to Group I and II. If applicant chooses to elect Group I or II, examination of the Generic claims will be examined only to the extent that they read on the elected invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Jane Potter on 08-01-2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (703) 308-7523. The examiner can normally be reached on Monday-Friday 8:30-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Karen A. Lacourciere
August 29, 2002


PATENT EXAMINER